

PETITION UNDER 37 C.F.R. §1.181
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application
Inventor(s): Raymond W. Ellis
Application No.: 09/899,833
Confirm. No.: 9671
Filed: July 5, 2001
Title: Automated Tool Management In A
Multi-Protocol Environment

PATENT APPLICATION

Art Unit: 2143
Examiner: Jean Gilles, J.

PETITION UNDER 37 C.F.R. §1.181

Mail Stop: Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants file this Petition to request that the Director withdraw the Notice of Abandonment recently issued in U.S. Application Serial No. 09/899,833 (the “‘833 Application”). Applicants believe the Notice of Abandonment was erroneously issued in the ‘833 Application.

Statement of Facts

On October 24, 2007, the United States Patent & Trademark Office (USPTO) issued a Notice of Abandonment (“Notice”). The Notice indicates that the ‘833 Application was abandoned because Applicants failed to timely file corrected drawings. As shown below, the USPTO accepted substitute drawings previously filed by the Applicants on September 17, 2001. Therefore, Applicants believe the Notice of Abandonment was issued in error.

I. Applicants Filed Substitute Drawings Sheets On September 17, 2001 That Complied With 37 C.F.R. §1.184.

On August 20, 2001, the USPTO mailed a Notice of Missing Parts to Applicants. The Notice of Missing Parts, among other things, indicated that substitute drawings in compliance

with 37 CFR 1.84 were required because the drawing sheets (i) do not have appropriate margins, and (ii) are not electronically reproducible.

On September 17, 2001, Applicants timely filed a response to the Notice of Missing Parts. Among other things, Applicants submitted thirteen substitute drawing sheets. Each of the substitute drawing sheets complied with 37 CFR 1.84. Applicants submit herewith a complete and accurate copy of the response to the Notice of Missing Parts (Exhibit A).

The response to the Notice of Missing Parts was received by the USPTO on September 21, 2001. Applicants submit herewith a complete and accurate copy of the Image File Wrapper for the '833 Application (Exhibit B). The Image File Wrapper contained in Exhibit B was printed from the USPTO's Public PAIR database.

II. The Substitute Drawing Sheets Submitted To The USPTO On September 17, 2001 By Applicants Were Accepted by the USPTO.

The USPTO mailed four Office Actions during prosecution of the '833 Application. The first three Office Actions indicated that the substitute drawing sheets submitted by Applicants on September 17, 2001 were acceptable.

On November 29, 2004, the USPTO mailed a first Office Action. In the first Office Action, the Examiner indicated that the thirteen substitute drawing sheets submitted by Applicants were accepted by the USPTO. Box 10a of the Office Action Summary page is checked, and indicates that the drawings received by the USPTO on September 21, 2001 are acceptable. Applicants submit herewith a complete and accurate copy of the first Office Action (Exhibit C).

On August 24, 2005, the USPTO mailed a second Office Action. In the second Office Action, the Examiner did not check either Box 10a (indicating that the substitute drawing sheets were acceptable) or Box 10b (objecting to the substitute drawing sheets). As previously discussed above, the substitute drawings sheets submitted by Applicants on September 17, 2001

were previously accepted by the Examiner in the first Office Action. Applicants submit herewith a complete and accurate copy of the second Office Action (Exhibit D).

On June 6, 2006, the USPTO mailed a third Office Action. In the third Office Action, the Examiner reconfirmed that the substitute drawing sheets submitted by Applicants on September 17, 2001 were acceptable. Box 10a on the Office Action Summary page is checked, and indicates that the drawings received by the USPTO on September 21, 2001 are acceptable. Applicants submit herewith a complete and accurate copy of the third Office Action (Exhibit E).

III. The Fourth Office Action Objected to Drawings That Were Never Filed In The ‘833 Application

On February 27, 2007, the USPTO mailed a fourth Office Action. In the fourth Office Action, the Examiner objected to drawings allegedly submitted by Applicants on August 24, 2001. Box 10b of the Office Action Summary page is checked objecting to drawings filed on August 24, 2001. Applicants submit herewith a complete and accurate copy of the fourth Office Action (Exhibit F).

Applicants never filed any substitute drawing sheets on or about August 24, 2001. As discussed above, the USPTO already accepted the substitute drawing sheets filed by Applicants on September 17, 2001 – more than six years prior to mailing the fourth Office Action.

On March 13, 2007, Applicants conducted an Examiner Interview to discuss the erroneous drawing objection contained in the fourth Office Action. As a result of the Interview, the Examiner acknowledged (i) that the drawing objection cited in the fourth Office Action was erroneous, and (ii) the substitute drawing sheets submitted by Applicants on September 17, 2001 were acceptable. The results from the March 13 Examiner Interview are documented in Applicants’ response to the fourth Office Action dated March 29, 2007 (see p. 13 of the response). Applicants submit herewith a complete and accurate copy of Applicants’ response to the fourth Office Action (Exhibit G).

IV. Applicants Timely Paid The Issue Fee

On June 27, 2007, the USPTO mailed a Notice of Allowance. Box 5 of the Notice of Allowability indicated that the Applicants must submit corrected drawings as replacement sheets with the payment of the issue fee. Applicants submit a true and accurate copy of the Notice of Allowance (Exhibit H).

On September 27, 2007, Applicants timely paid the issue fee for the '833 Application. Applicants did not resubmit the substitute drawing sheets with the payment of the issue fee. Applicants reasonably relied on the results of the March 13, 2007 Examiner Interview that the Examiner would resolve the erroneous drawing objection contained in the fourth Office Action.

V. The Examiner Has Attempted To Withdraw The Notice Of Abandonment

Applicants thank the Examiner for his efforts to resolve this matter. Applicants received the Notice of Abandonment on October 29, 2007. Applicants submit herewith a true and accurate copy of the Notice of Abandonment (Exhibit I).

On October 31, 2007, Applicants contacted the Examiner to discuss the Notice of Abandonment. As a result of the October 31 conference call with the Examiner, the Examiner indicated that he would request that the Notice of Abandonment be withdrawn.

The Examiner, over the past two months, has repeatedly attempted to withdraw the Notice of Abandonment. On November 28, 2007, Applicants spoke with the Examiner via telephone. During the telephone conference call with the Examiner, the Examiner indicated that he submitted a written summary to the USPTO stating that the '833 Application has been wrongfully abandoned and the Notice of Abandonment should be withdrawn within approximately two weeks.

On January 2, 2008, Applicants again spoke with the Examiner to discuss the status of withdrawing the Notice of Abandonment issued in the '833 Application. As a result of the January 2 telephone conference call with the Examiner, the Examiner suggested that Applicants contact the Office of Petitions because the Examiner cannot resolve this matter.

On January 3, 2008, Applicants spoke with a paralegal at the Office of Petitions. The paralegal suggested that Applicants file a Petition Under 37 C.F.R. 1.84 requesting withdrawal of the Notice of Abandonment.

Arguments

- I. The Notice Of Abandonment Was Erroneously Issued By The United States Patent & Trademark Office And Should Be Withdrawn**
 - a. The Substitute Drawing Sheets Filed By Applicants On September 17, 2001 Were Accepted By The United States Patent & Trademark Office**

Applicants submitted thirteen substitute drawing sheets to the USPTO on September 17, 2001. The substitute drawing sheets were received by the USPTO on September 21, 2001. The USPTO repeatedly accepted these thirteen substitute drawing sheets. In particular, box 10a on the Office Action Summary page of the first Office Action was checked, and expressly states that “the drawings filed on 21 September 2001 is/are” accepted.

Box 10a on the Office Action Summary page of the second Office Action was not checked. However, box 10b was not checked either. Box 10b would have been checked if the substitute drawing sheets were objected to by the Examiner. It was reasonable for the Applicants to assume that the Examiner simply forgot to check box 10A to reconfirm that the substitute drawing sheets received from Applicants on September 21, 2001 were acceptable. Thus, Applicants relied on the Examiner’s statement in the first Office Action indicating that the substitute drawing sheets submitted by Applicants were still acceptable.

The third Office Action confirmed that the substitute drawing sheets received by Applicants on September 21, 2001 were still acceptable. Box 10a of the Office Action Summary page of the third Office Action was checked, and expressly states that “the drawings filed on 21 September 2001 is/are” accepted.

b. The Fourth Office Action Objected To Drawings That Do Not Exist

The fourth Office Action issued in the prosecution of the ‘833 Application objected to drawings filed by Applicants on August 24, 2001. Box 10b of the Office Action Summary page was checked by the Examiner objecting to these drawings allegedly filed by the Applicants on August 24m, 2001. No such drawings exist.

The Image File Wrapper submitted by Applicants illustrates that the thirteen substitute drawing sheets submitted by Applicants were received by the USPTO on September 21, 2001. The Image File Wrapper further illustrates that Applicants did not file, nor did the USPTO receive, any drawing sheets on or about August 24, 2001. Therefore, Applicants respectfully suggest that the Examiner objected to drawing sheets that were never submitted by Applicants in the ‘833 Application.

c. Applicants Reasonably Relied On The Examiner To Resolve The Objection To Non-Existence Drawing Sheets

Applicants conducted an Examiner Interview on March 13, 2007 after receiving the fourth Office Action (dated February 27, 2007). As a result of the Examiner Interview, the Examiner agreed with Applicants that the objection to drawings filed by Applicants on August 24, 2001, which was contained in the fourth Office Action, was in error. The Examiner also acknowledged that the substitute drawing sheets submitted by Applicants on September 17, 2001 were acceptable.

Applicants reasonably believed that the Examiner removed the drawing objection in the ‘833 Application, and the Examiner’s action simply had not been reflected in the Notice of Allowability. Thus, Applicants proceeded to pay the issue fee without resubmitting the already accepted substitute drawing sheets.

II. Applicants Promptly And Timely Filed This Petition

Applicants have attempted to resolve this matter with the Examiner since October 31, 2007. The Notice of Abandonment was mailed by the USPTO on October 24, 2007. Any

petition under 37 C.F.R. 1.181 to withdraw the holding of abandonment filed within two months of the mail date of the Notice of Abandonment is considered timely. Two months from the mail date of the Notice of Abandonment expired December 24, 2007. For the reasons discussed below, Applicants respectfully suggest that this Petition is timely filed even though the Petition is not filed within two months of the mail date of the Notice of Abandonment.

Applicants called the Examiner two days after receiving the Notice of Abandonment (October 29, 2007) to discuss this matter. Applicants have diligently kept in contact with the Examiner since October 31, 2007 in an attempt to resolve this matter. Over the past two months, Applicants have conducted four telephone conference calls with the Examiner discussing this matter. In each conference call with the Examiner, the Examiner assured Applicants that the Examiner has requested withdrawal of the Notice of Abandonment, and the Notice of Abandonment will be withdrawn shortly. Applicants had no reasons to believe that the Notice of Abandonment would not be withdrawn. Therefore, Applicants did not have any reason to file a Petition to withdraw the Notice of Abandonment within the customary two-month period of time after the Notice of Abandonment was mailed by the USPTO.

On January 2, 2008, the Examiner contacted Applicants to convey that the Examiner's efforts to withdraw the Notice of Abandonment have not been successful. Thus, Applicants must file a Petition to request the withdrawal of the Notice of Abandonment.

On January 4, 2008, only two days after speaking with the Examiner on January 2, Applicants filed this Petition with the USPTO. Therefore, Applicants have promptly and timely filed this Petition.

Conclusion

Applicants respectfully request that the United States Patent & Trademark Office (USPTO) grant this Petition and withdraw the Notice of Abandonment.

Applicants have paid the issue fee for the '833 Application. Thus, when the USPTO grants this Petition, Applicants respectfully request that the USPTO allow the '833 Application to proceed to issue as a United States Patent.

Respectfully submitted,

Date: January 4, 2008

By: /Scott D. Sanford/

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